

REMARKS

In response to the Decision on Appeal issued July 29, 2011 (the “Decision”), Applicant requests the preceding amendments and consideration of the following remarks.

Status of Claims

Claims 3-5, 19 and 57 were cancelled previously without prejudice or disclaimer.

Under the imposition of a previous Restriction Requirement, claims 21-36 and 45-47 were withdrawn from consideration and cancelled without prejudice or disclaimer.

Thus, claims 1, 2, 6-18, 20, 37-44 and 48-56 are currently pending in the application and were subject to the Decision.

Grounds of Rejection

The final Office Action raised the following grounds of rejection.

(1) Claims 1, 2, 6-9, 18, 20, 37, 38 and 42-44 were rejected under 35 U.S.C. § 103(a) over the combined teachings of Hamada et al (JP Patent No. 405251705A) (“Hamada”), Phillips et al. (“Transparent Conducting Thin Films of GaInO₃,” Appl. Phys. Lett. Vol. 65 (1), July 1994) (“Phillips”) and Narushima et al. (“Electronic structure and transport properties in the transparent amorphous oxide semiconductor 2 CdOGeO”, Phys Rev. B 66, 035203-1, 7/16/2002) (“Narushima”).

(2) Claims 10-13 and 39 were rejected as being unpatentable under 35 U.S.C. § 103(a) over the combined teachings of Hamada, Phillips, Narushima and Minami (of record).

(3) Claims 14-17 and 40-41 were rejected as being unpatentable under 35 U.S.C. § 103(a) over the combined teachings of Hamada, Phillips, Narushima, Minami (of record) and “D” (“Transparent Conducting PbO₂ films prepared by activated reactive evaporation,” Phys. Rev. B 33, 2660-2664 (1986) (“D”).

(4) Claims 48-52 were rejected as being unpatentable under 35 U.S.C. § 103(a) over the combined teachings of U.S. Patent No. 6,476,788 to Akimoto (“Akimoto”), Hamada, Phillips and Narushima.

(5) Claims 53 and 54 were rejected as being unpatentable under 35 U.S.C. § 103(a) over the combined teachings of Akimoto, Hamada, Phillips, Narushima and Minami (of record).

(6) Claims 55 and 56 were rejected as being unpatentable under 35 U.S.C. § 103(a) over the combined teachings of Akimoto, Hamada, Phillips, Narushima, Minami and D.

All of these rejections were reversed in the Decision.

The Decision instituted two new grounds of rejection under 37 C.F.R. § 41.50(b).

(1) Claims 1, 2, 6-18, 20, 37-44 and 48-56 were rejected under 35 U.S.C. §112, second paragraph. (Decision, p. 8).

(2) Claims 6-17, 38-40 and 51-56 were rejected under 35 U.S.C. § 112, fourth paragraph. (Decision, p. 10).

As explained below, the amendments to the claims offered in this paper address both of these rejections. In particular, claims 6, 38 and 51 have been amended herein and rewritten as independent claims. In each case, the exact language of the corresponding base claims has been added to each of claims 6, 38 and 51. Consequently, no new issues or subject matter are raised.

(1) 35 U.S.C. § 112, Second Paragraph:

According to the Decision, the independent claims of the application are rendered confusing and indefinite because they are subject to two different interpretations, i.e., whether the phrase “compounds of the formula $A_xB_xO_x$ ” is open or closed-ended. (Decision, p. 7). This question arises specifically under the doctrine of claim differentiation because dependent claims, such as claims 6, 38 and 51, recite that $A_xB_xO_x$ of the independent claims includes an additional element, e.g., C_x in claim 6, D_x in claim 10, etc.

To resolve this issue, Applicant has herein amended claims 6, 38 and 51 so that each is its own independent claim. Consequently, the recitations of these claims and their dependent claims no longer impact the scope or interpretation of the independent claims.

As a result, the independent claims are now subject only one interpretation. The additional interpretation of the language is now embodied in and applicable only to the new independent claims, 6, 38 and 51, and their dependent claims.

Therefore following the entry of this amendment, the rejection under 35 U.S.C. §112, second paragraph, can be reconsidered and withdrawn.

(2) 35 U.S.C. § 112, Fourth Paragraph:

This rejection is based on the holding that claims 6-17, 38-40 and 51-56 do not limit the subject matter of their respective independent claims. This rejection is based on the same issue as the rejection above under § 112, second paragraph.

As noted above, in the present paper, claims 6, 38 and 51 have been amended to become independent claims. Following entry of this amendment, there is no longer any issue as to whether these now-independent claims further limit their previous base claims.

Therefore following the entry of this amendment, the rejection under 35 U.S.C. §112, fourth paragraph, can be reconsidered and withdrawn.

Conclusion:

Following entry of this amendment, all the issues presented in the Decision are thought to have been completely resolved. Consequently, the present application should be in condition for immediate allowance, and notice to that effect is respectfully requested.

If the Examiner has any comments or suggestions which could place this application in better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

DATE: 28 September 2011

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